

REMARKS

Claims 1-5, 7, 9-11, 13, 15-17, 33-40 and 42 are pending in the present Application as a result of the February 18, 2009 amendment being entered. Claims 43-48 have been added, leaving Claims 1-5, 7, 9-11, 13, 15-17, 33-40 and 42-48 for consideration upon entry of the present Amendment.

Antecedent basis for new Claims 43-48 can be found at least as follows.

Claim 43: Claim 1, paragraphs [39], [43], [45] and [83].

Claim 44: Paragraph [83].

Claim 45: Paragraph [45].

Claim 46: Claim 1, paragraphs [26], [30], [39], [45] and [83].

Claim 47: Paragraph [83].

Claim 48: Paragraph [45].

No new matter has been introduced by these amendments. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Examiner Interview Summary

The undersigned thanks Examiner Chriss for the courtesy shown in interviewing this instant application on March 11, 2009. During that interview, all previously entered amendments, as well as potential new claim elements, were discussed in view of Randall, Ali, and Deodhar.

Claim Rejection Under 35 U.S.C. § 103(a)

Claims 1-5, 7, 9-11, 13, 15, 21-29 33, 35-39 and 41-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall et al. (US 2002/0155282, hereinafter “Randall”) in view of Ali (U.S. Patent No. 4,647,486) and further in view of Deodhar et al. (US 2002/0113572, hereinafter “Deodhar”).

All of the claims in the instant application require that the coating penetrates the first fiber mat from the first side into the fiber mat to a depth of about 30 percent to about 50 percent of the thickness of the fiber mat. Applicants maintain that this is a key element that is not taught or suggested in the prior art.

Applicants discuss the relationship between coating penetration and tensile bond in paragraph [104], for example. Indeed, in this instant example, even when the formulation from Randall (U.S. 2002/0155282) is employed, if the coating penetration is outside of the claimed range, blistering can occur in the board resulting in a rejected board (see table). For clarity in the record, Applicants note that this limitation in itself may provide novel and non-obvious subject matter that would form the basis of allowance. Applicants continue to reserve the right to revisit this claimed subject matter in continuation applications.

However, in efforts to expedite allowance, Applicants have previously amended the claims to include additional limitation that are also not taught or suggested by the prior art. Specifically, all of the claims also have the limitation that “the mineral pigment has a particle size such that at least about 95 percent by weight of the mineral pigment particles pass through a 100 mesh wire screen, with about 75 percent of the particles by number being greater than 5 microns.” (Emphasis added).

The Final Office Action dated January 5, 2009 agrees that this additional limitation is missing from the prior art. Specifically, “Randall in view of Ali and Deodhar...fails to teach that about 75% of the particles by number are greater than 5 microns as required by claims 33 and 41 and number average particle size of about 40 microns as required by claim 42.” (Final Office Action, page 10). Even though the references fail to teach or suggest this element, the Final Office Action stated that “it would be obvious to one of ordinary skill in the art at the time the invention was made to optimize the particle size of greater than 5 microns or to a number average particle size of about 40 microns to control the porosity.” (Final Office Action, page 10). Applicants respectfully disagree.

Specifically, Deodhar, when considered as a whole, appears to be suggesting the importance that soy protein has on porosity, rather than the importance of optimizing particle sizes. Deodhar teaches that “coating porosity is enhanced through the addition of soy protein.” (Paragraph [0028]). Moreover, all of the claims of Deodhar require a soy protein. A person of skill in the art would not have been motivated to optimize the particle size as suggested in the Final Office Action, but rather be directed toward the use of soy protein. For these reasons, Applicants additional claim limitation that about 75%

of the particles by number are greater than 5 microns as required by claims 1 and 33 and number average particle size of about 40 microns as required by claim 42 are not taught or suggested. For at least this reason, Applicants respectfully submit that the instant case is in a condition for allowance.

Claim 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Randall et al. (US 2002/0155282) in view of Ali (U.S. Patent No. 4,647,486) and Deodhar et al. (US 2003/0113572), and further in view of Kennedy et al. (US 5,484,653)

As noted above, the use of Deodhar et al. in combination with Randall et al. and Ali fail to establish a *prima facie* case of obviousness. Kennedy et al. fail to cure the deficiencies of Deodhar et al., Randall et al, and Ali. More particularly, Kennedy et al. is relied upon in the Office Action for teaching details about glass mats. However, Kennedy et al. does not teach the claimed limitation that the mineral pigment has a particle size such that at least about 95 percent by weight of the mineral pigment particles pass through a 100 mesh wire screen, with about 75 percent of the particles by number being greater than 5 microns. Rather, the Office Action had relied upon Deodhar et al. for teaching this element. However, as noted above, Deodhar et al. do not teach or suggest this element. For at least this reason, independent Claim 33 is allowable. As such, Claim 34 is allowable for at least the reason that it depends from an allowable independent claim.

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with the undersigned would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fees be charged to Deposit Account No. 50-3313.

Respectfully submitted,

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